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**Datasheet for the decision
of 5 March 2024**

Case Number: T 2689/19 - 3.3.08

Application Number: 13824232.6

Publication Number: 2764103

IPC: C12N15/63

Language of the proceedings: EN

Title of invention:

CRISPR-Cas systems and methods for altering expression of gene products

Patent Proprietor:

The Broad Institute, Inc.
Massachusetts Institute of Technology

Opponents:

Schlich, George
Boxall Intellectual Property Management Limited
Grund, Dr., Martin
Wächtershäuser & Hartz
Patentanwaltpartnerschaft mbB/
Blodig, Wolfgang
CRISPR Therapeutics AG
Storz, Dr. Ulrich
Jones Day

Headword:

CRISPR/THE BROAD INSTITUTE, MASSACHUSETTS INSTITUTE OF TECHNOLOGY

Relevant legal provisions:

EPC Art. 87, 88, 89, 111(1), 112(1) (a), 113(1)
RPBA 2020 Art. 11, 12, 13

Keyword:

Entitlement to priority - (yes)
Remittal to first instance - (yes)
Referral of questions to the EBoA - (no)
Admission of late filed documents and arguments - (yes)

Decisions cited:

G 0001/84, G 0005/88, G 0009/93, G 0004/98, G 0002/07,
G 0002/08, G 0003/19, G 0001/22, T 0390/90, T 0015/01,
T 1242/04, T 0577/11, T 1201/14, T 1919/17, T 0521/18,
T 1913/19, T 2719/19, T 1006/21, T 1946/21, J 0008/00,
T 0844/18

German cases

(BGH) X ZR 83/21- Sorafenib-Tosylat;
(BGH) X ZR 74/21 - Happy Bit.

Swiss cases

Mepha Pharma AG v Bristol-Myers Squibb Holdings Ireland
Unlimited Company, BPatGer, Urteil O2022_007,
Bayer HealthCare LLC v Helvepharm AG, BPatGer, Teilurteil
O2022_006.
Marcel Riendeau v Zehnder Group, Swiss Federal Patent Court
(BPatGer), Urteil O2015_009

French cases

Magiq Technologies v Swisscom, Court of First Instance Paris
(Tribunal de Grande Instance Paris), 28 September 2007

UK cases

Accord Healthcare Ltd v Research Corporation Technologies, Inc
[2017] EWHC 2711 (Pat); [2018] R.P.C.4

Catchword:

Presumption of priority



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Case Number: T 2689/19 - 3.3.08

D E C I S I O N
of Technical Board of Appeal 3.3.08
of 5 March 2024

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 26 September
2019 revoking European patent No. 2764103
pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chair T. Sommerfeld
Members: M. Montrone
 D. Rogers
 D. Pilat
 R. Winkelhofer

Summary of Facts and Submissions

I. This is an appeal by the patent proprietors ("the appellants") against the decision of the opposition division to revoke the patent.

Preliminary note

II. For ease of reading, the submissions of the opponents will not be identified by reference to a particular opponent, unless this is necessary in order to identify a particular submission. The opponents will be referred to as the opponents (not as the respondents).

III. The following documents are referred to in this decision:

D158: The Broad Institute press release dated
15 January 2018, 1-3

D218: US2015/0184139 A1

D388: T. O'Connor Statement (Rockefeller University),
dated 15 December 2023

IV. Any reference to Enlarged Board of Appeal decision G 1/22 is to be taken as also being a reference to G 2/22.

V. The patent in suit (European patent no. 2 764 103) is related to a CRISPR-Cas 9 system to be used in eukaryotic cells. It is based on European patent application no. 13 824 232.6 resulting from an international PCT application no. PCT/US2013/074743 ("PCT 743") published as WO 2014/093661 that claimed

priority from six earlier US provisional applications. These earlier US provisional applications were referred to as P1, P2, P5, P11, P13 and P14 before the opposition division. The board also adopts this notation.

VI. The opposition division found that out of all the priority documents, P1, P2, P5, P11, P13 and P14, priority was not validly claimed from P1, P2, P5 and P11 and hence that the patent as granted lacked novelty over the prior art document D3. Since, moreover, none of the twenty-one auxiliary requests (AR1 to AR21) were found to overcome the novelty objection based on document D3, they were not admitted and considered in the proceedings. Thus, the opposition division revoked the patent.

Background I - US provisional applications and US inventors in general

VII. The board finds it useful to set out its understanding of US patent applications, the board having arrived at this understanding upon the basis of the submissions made by the parties during the course of the appeal proceedings. In the United States it is common practice for the inventor to appear on a patent application, when it is first filed, not only as the inventor, but also as the proprietor. This remains the case even after the amendments introduced to the law by the Leahy-Smith America Invents Act in 2012-13 that did away with the strict requirement to have only inventors as applicants. The ownership of the patent application is then subsequently transferred to, in a typical case, the inventor's employer.

- VIII. This practice gives the naming of an inventor in the US system greater importance than in the EPO system. This is because in the US system the correct naming of an inventor is not simply a moral right, or a question of personal prestige, but can also be essential for determining the subsequent ownership of the application and the resulting patent.
- IX. US [provisional applications under 35 U.S.C. § 111\(b\)](#) are patent applications with some special features that make them very different from an application for a European patent. The sole purpose of a US provisional application is to acquire a filing date for the subject matter disclosed, such that priority can be claimed in a subsequent non-provisional patent application for an invention disclosed in the provisional application.
- X. If there are multiple inventors, each inventor must be named in the provisional application. All inventors named in the provisional application must have made a contribution, either jointly or individually, to the invention, or inventions, disclosed in the provisional application. A US provisional application, unlike a European application, may contain a specification setting out several different inventions, with inventors named on the provisional application even if they have not contributed to all of the inventions disclosed therein, but only to some of them. Following this filing, the inventions are separated out from one another and the inventors are assigned to their inventions in a procedure that results in actual patent applications. As stated above, in US practice, the inventor is also usually named as the first applicant. This practice reinforces the importance of being named as inventor in the determining of ownership of the patent application and subsequent patent.

XI. Thus, when subsequent PCT applications are filed, as in this case, the different inventions are claimed in separate PCT applications, each claiming priority from the US provisional application(s) that disclosed that invention. In addition the PCT applications name the inventor-applicants that contributed to the claimed invention, and their successors in title, if any. Thus at the PCT application stage, both the invention and the inventors have been separated out from the contents of the US provisional application.

Background II - US provisional applications and US inventors in the present case

XII. Each of the US provisional applications from which priority is claimed in this case had several inventor-applicants. There was a considerable overlap between the inventor-applicants for each priority document.

XIII. For the understanding of this decision, it is particularly important that L. Marraffini ("Marraffini") was named as one of the inventors in each of P1, P2, P5 and P11 and that Marraffini is not named as an inventor of the patent in suit. Marraffini was at the relevant times an employee of the Rockefeller University.

XIV. There was a dispute in the United States regarding whether Marraffini should also be named as one of the inventors in PCT 743, from which the patent in suit is a divisional, and about the ownership of this patent.

XV. Marraffini wished to be named as one of the inventors, and the Rockefeller University wished to be named as one of the proprietors (co-owners), alongside the

appellants in the present case. The Rockefeller University was the successor in title of Marraffini.

XVI. This inventorship and ownership dispute was resolved in January 2018 - with the parties having agreed to submit their dispute to binding arbitration. An independent arbitrator decided that, *inter alia*, neither Marraffini should be named as an inventor, nor the Rockefeller University should be named as a proprietor of PCT 743 (further see, *inter alia*, D158, D388).

This dispute will be referred to as the "inventorship dispute".

First instance proceedings

XVII. Although the decision of the opposition division and the pleadings of the parties cover many issues, this decision turns on a single issue, the finding by the opposition division that the patent in suit was not entitled to claim priority from P1, P2, P5 and P11.

XVIII. The opposition decision reached their decision on whether the patent was entitled to priority by applying the established practice of the EPO in assessing the validity of a formal claim to priority, and the established practice regarding the applicants' identity, the so-called "all applicants approach" (cf. G 1/22, reasons 39).

XIX. The opposition division found that the proprietors were not able to make a valid priority claim because neither Marraffini nor the Rockefeller University were named as applicants in PCT 743 (and consequently in the patent in suit). Applying the "all applicants approach", as P1, P2, P5 and P11 were filed by (joint) applicants

(Marraffini or the Rockefeller University being amongst these applicants), either all of them, or their successors in title, should be applicants for the patent in suit. This was not the case, Marraffini and the Rockefeller University were missing, thus priority was not validly claimed for PCT 743 which led to a finding that the patent in suit was not novel.

Appeal Proceedings

- XX. Following the decision of the opposition division, and during the present appeal proceedings, the established practice of the EPO as regards validly claiming priority was reviewed and revised in the Enlarged Board's decision G 1/22 of 10 October 2023.
- XXI. In a communication dated 5 February 2024, the board gave its opinion on the priority entitlement of the patent from P1, P2, P5 and P11 in the light of the decision in G 1/22.
- XXII. In the communication, the board noted that G 1/22 established a presumption that a claim to priority was valid, by way of an implicit agreement on the transfer of the right to claim priority, which applied to any case where the subsequent applicant was not identical with the priority applicant. Such an implicit agreement should, according to G 1/22, be accepted under almost any circumstances, including *ex-post* (retroactive, *nunc pro tunc*, *ex tunc*) transfers concluded after the filing of the subsequent application.

G 1/22 further provided that such a presumption could be rebutted in "rare exceptional cases". Such a rebuttal would require evidence that an agreement, whether implicit or explicit, did not exist. There was

no evidence rebutting this presumption in the present case, rather there was evidence that supported the presumption. The inventorship dispute had been settled, with the very purpose of safeguarding the inventions made together, notably by ensuring patent protection for all of them. Applying G 1/22, it contained (and confirmed that there was), at least, an implicit agreement *nunc pro tunc* and thus the presumption of entitlement to priority on the earliest date on which priority was claimed. G 1/22 explicitly stated that *ex post* transfer of priority rights was allowed and, as for being retroactive, the at least implicit transfer agreement by way of the settlement of the inventorship dispute related to this date, and confirmed that the presumption of entitlement existed. As also stated in G 1/22, there was always a party who was entitled to claim priority, even if this party had to be determined in national proceedings. It was the same if the entitlement dispute was settled outside the courts, by way of amicable settlement or arbitration as was the case here. As the case clearly showed, only the presumption of entitlement to priority finally guaranteed that there was a party being entitled to claim priority, and that this right was not "lost" somewhere in an inventorship dispute. Hence priority was validly claimed.

The board concluded that the consequence of this finding would be the setting aside of the decision under appeal, and the remittal of the case to the opposition division for further prosecution.

XXIII. The opponents responded to this communication, and argued that the board had wrongly assumed a retroactive transfer of the priority rights from Marraffini (or the Rockefeller University) to the applicants for PCT 743

(these applicants being the appellants in this case). For the opponents, the board's assumption came from the finding that an at least implicit transfer agreement by way of the settlement of the inventorship dispute had taken place, in view of the press release D158 and the T. O'Connor Statement D388. The opponents then went on to criticise this approach, and they provided evidence to show that retroactive assignments of priority rights were not always operative under US law.

The opponents further argued that there was no evidence on file of an explicit, or implicit, transfer of the priority rights. Further, documents D158 and D388 concerned an inventorship dispute and nothing in these documents supported the existence of a transfer of the priority rights; rather the existence of the inventorship dispute between Marraffini/Rockefeller University and the appellants was evidence that an agreement to transfer the priority rights did not exist. The opponents noted that a PCT application was filed with Marraffini as inventor and the Rockefeller University as applicant, claiming priority from P1 and P2, on the same day as PCT 743 was filed. Given that this took place during an inventorship dispute, it was further evidence that Marraffini/Rockefeller University would not have intended that PCT applications omitting them should enjoy the same priority rights as the PCT application in which they were named.

The opponents also pointed out that the appellants' position in their grounds of appeal was that Marraffini had no rights in the invention claimed in the patent application, and therefore could not transfer anything to the appellants. This was contrary to the position that the appellants adopted in their submission of 27 February 2024, where they argued for a transfer of

rights to priority from Marraffini/Rockefeller University to the appellants. These latter arguments should not be admitted and considered in the proceedings.

XXIV. Thus, in the opponents' view the evidence and arguments on file constituted a rebuttal of the presumption that priority was validly claimed.

XXV. The appellants basically agreed with the board's preliminary assessment.

XXVI. The appellants request that the decision under appeal be set aside, and that the case be remitted to the opposition division for further prosecution.

XXVII. The opponents' substantive requests are that:

the appeal be dismissed; that questions be referred to the Enlarged Board of Appeal, in the case that the decision of the opposition division on priority be overturned; and that the case be remitted to the opposition division for further prosecution.

The suggested questions to refer to the Enlarged Board of Appeal concerned

- a "retroactive effect" of "the new interpretation of Article 87(1) EPC" by G 1/22

- the possibility of "a retroactive transfer" under the EPC, and, if so, the point in time when "this change in law and practice [should] take effect"

- the relevant date for the right to claim priority and the standard of proof for a retroactive assignment of the priority right.

Reasons for the Decision

Admission and consideration of documents and arguments

1. The opponents requested that the arguments concerning the transfer of the priority right in the appellants' submissions of 27 February 2024 not be admitted into the proceedings.

Articles 12 and 13 RPBA 2020 serve to take account of changes in the facts or the subject-matter of appeal proceedings ("amendments" within the meaning of Articles 12(4) and 13(1) and (2) RPBA), within narrow limits (see [T 1006/21](#), reasons 25, with reference to T 1919/17, reasons 25, and T 1913/19, reasons 10 and 16). Decision G 1/22 of the Enlarged Board of Appeal directly applied to the present case and required that the parties be given an opportunity to be heard on the consequences of the Enlarged Board's decision (see Article 113(1) EPC), and not, to the contrary, being prevented from filing submissions by Articles 12 and 13 RPBA. In fact the present proceedings were stayed while awaiting the outcome of the proceedings before the Enlarged Board so as to give the parties and the board the opportunity to take said outcome into consideration. The appellants' submissions of 27 February 2024 are thus admitted into the proceedings.

Entitlement to priority: Enlarged Board of Appeal Decision G 1/22 and implications for the present case

2. In reasons 105 of G 1/22, the Enlarged Board found that *"... entitlement to priority should in principle be presumed to exist to the benefit of the subsequent applicant of the European patent application if the applicant claims priority in accordance with Article 88(1) EPC and the corresponding Implementing Regulations. ..."*.

3. This presumption is based on the concept of an implicit (implied, tacit or informal) agreement on the transfer of the priority right from the priority applicant to the subsequent applicant:

"under almost any circumstances" (see G 1/22, reasons 99; cf. also reasons 106, 107, 122, 125, 126, 127; cf. also reasons 24, 67, 72, 86, 94).

It, notably, allows *ex-post* (retroactive, *nunc pro tunc*, *ex tunc*) transfers concluded after the filing of the subsequent application (see reasons 100 and 114). And, the Enlarged Board continues in reasons 100:

"However, the allowability of a retroactive transfer of priority rights may have limited practical relevance if priority entitlement is presumed to exist on the date on which priority is claimed for the subsequent European application".

4. The Enlarged Board found that a priority right and its transfer is a matter exclusively governed by the autonomous law of the EPC (reasons 86, 88, 90, 99, 101, 111, 126 ff, 133). Consequently, there is no room for the application of national laws on legal presumptions and their rebuttal (reasons 111).

5. The Enlarged Board further found that the presumption that the subsequent applicant is entitled to the

priority right is a strong presumption, under "*normal circumstances*" (see reasons 110).

6. In reasons 107 and 134, the Enlarged Board states that the presumption will apply to any case in which the subsequent applicant is not identical with the priority applicant, and thus also to a plurality of co-applicants for the priority application regardless of the extent to which that group overlaps with the co-applicants for the subsequent application.
7. This is the situation in the present case. Thus the presumption of a validly claimed priority applies.
8. G 1/22, in reasons 108, 131, further provides that the presumption can be rebutted, to take into account "*rare exceptional cases*" where the subsequent applicant cannot justifiably rely on the priority.
9. The rebuttable presumption thus involves the reversal of the burden of proof, i.e. the party challenging the subsequent applicant's entitlement to priority has to prove that this entitlement is missing. Just raising speculative doubts - even if these are "*serious*" as in the words of the Enlarged Board (see G 1/22, reasons 110, 113) - is not sufficient: to put into question the subsequent applicant's entitlement to priority, (full) evidence would be needed (see reasons 110, 126).
10. The concept as developed in G 1/22 of the rebuttable, but strong presumption for the right to claim priority, to be assessed under the autonomous law of the EPC, has recently been endorsed by the German Bundesgerichtshof (BGH) in [X ZR 83/21](#), GRUR-RS 2023, 37747, Rnn. 110, 120 ff. - *Sorafenib-Tosylat*, and [X ZR 74/21](#), Rnn. 67 ff. - *Happy Bit*. Notably, the BGH underlined that the

Enlarged Board's reasoning was persuasive and yielded realistic and appropriate results, and that the mere challenging of another party's submissions was not sufficient to rebut the presumption.

11. The "evaluation of evidence" and the conclusion on an implicit transfer agreement in G 1/22 was also found persuasive in the jurisprudence of the Swiss Federal Patent Court (Bundespatentgericht) in *Mepha Pharma AG v Bristol-Myers Squibb Holdings Ireland Unlimited Company*, [BPatGer, Urteil O2022_007](#), Rn. 30; cf also *Bayer HealthCare LLC v Helvepharm AG*, [BPatGer, Teilurteil O2022_006](#).
12. It has also already been reflected in the boards' jurisprudence (T 2719/19, reasons 4 ff, T 521/18, reasons 2).
13. In the present case, the parties have made extensive submissions on whether Marraffini/Rockefeller University made a transfer of the rights to make a priority claim to the appellants. The opponents' arguments were mainly based upon the contents of documents D158 and D388.
14. These documents concern the resolution of the inventorship dispute and say nothing about priority entitlement. This is also the position of the opponents. From this, the opponents argue that these documents do not provide any basis for inferring the existence of an implicit transfer of the priority rights from Marraffini/Rockefeller University to the appellants.
15. The opponents are thus arguing that the appellants have not provided evidence that they are entitled to the

priority rights they claim.

16. However, this is precisely what the presumption in G 1/22 states: that the appellants do not have to provide such evidence, but the opponents have to rebut the presumption.
17. There is no evidence that rebuts this presumption in the present case.
18. If at all, there is evidence to the contrary, which supports the presumption of an implied transfer agreement.
19. The opponents point out, in this context, that Marraffini and the Rockefeller University also filed a patent application (D218) naming in addition F. Zhang as co-inventor and the Broad Institute and MIT as co-applicants. This patent application claimed priority *inter alia* from P1 and P2 and was filed during the inventorship dispute. Thus they could not have consented to the appellants also filing applications claiming, *inter alia*, these priorities.
20. However, it is common ground between the parties that the inventorship dispute between Marraffini/Rockefeller University and the appellants was settled in 2018.
21. The entire purpose of the inventorship dispute was to have Marraffini named as inventor, and the Rockefeller University as proprietor, of PCT 743 (and some other PCT applications). In the absence of evidence to the contrary, it is not credible that Marraffini or the Rockefeller University would have acted in a way to invalidate the priority claim of a patent they were

seeking to be named as inventor of, and owner of, respectively.

22. Accordingly, as already set out in the board's communication, the very purpose of the final arbitration settlement was to safeguard the inventions made by Marraffini, alongside the other inventors, and ensuring their patent protection, not the least because of the parties' common interest in the validity of the necessary priority rights.
23. Such settlement of the dispute was, by definition, "retroactive", as putting an end to a dispute that arose in the past, and thus relates to the (earliest) date on which priority was claimed (see G 1/22, reasons 100, 109).
24. The settlement of the inventorship dispute is thus no "later development" (see G 1/22, reasons 109), but confirmed, to the contrary, an *ex-post* transfer agreement. Accordingly, history is not "rewritten", as asserted by the opponents.
25. However, for clarification, it is recalled that even in the absence of any evidence regarding the settlement of the inventorship dispute, the result would have been the same, based on the presumption of a valid priority claim, which has neither been rebutted by this nor any other evidence on file (see again G 1/22, reasons 100).
26. As also reiterated in G 1/22, reasons 114: There is always a party who is entitled to claim priority, even if this party has to be determined in national proceedings (with this being the same if the dispute is settled outside the courts, by way of amicable settlement or arbitration, as is the case here). Not

the least, the present case clearly shows that only the rebuttable presumption of a priority right guarantees that there is a party being entitled to claim priority, and that this right is not "lost" somewhere in an inventorship dispute.

27. Hence the entitlement to priority was validly claimed.
28. Given these findings, the further arguments of the opponents are without merit.
29. There is no requirement to further examine the inventorship dispute and its timeline, and the prosecution history before the USPTO, as well as "the factors leading to the settlement of the inventorship dispute", including the full text of the arbitration decision, as also requested by the opponents. All these circumstances do not have any bearing on the outcome of the case.
30. Likewise, as there is no room for an application of US law and its "standards", as also argued by the opponents, alongside or even instead of the autonomous law of the EPC, these questions also do not merit any further discussion. The same goes for the conclusions drawn by the opponents based on their premise.
31. There is also no point in arguing that "the present case clearly does not present "normal circumstances"", with reference to G 1/22, reasons 110, under which the presumption shall apply: this is only descriptive language of the Enlarged Board in developing their concept of the rebuttable presumption, and thus only reiterates that it rests with the other party to rebut the presumption, i.e. providing evidence that there are no "normal circumstances". However, it does not impose

a further condition of "normality" for the rebuttable presumption to come into play.

32. The opponents further claim that there was "no relevant change of the law" by G 1/22, and that the Enlarged Board has not departed from the "all applicants approach" as confirmed in T 844/18. This misreads G 1/22, reasons 107, 134, according to which - as outlined already above - the rebuttable presumption applies in any case where applicants are not identical, notably also where a plurality of co-applicants for the priority application only partly overlaps with the co-applicants of the subsequent application, which is the situation in the present case. Only in the context of a rebuttal may the circumstances of an individual case play a role.
33. Likewise, the reference to further jurisprudence before G 1/22 (namely T 577/11, T 1201/14 and T 1946/21), according to which "the relevant date for a valid succession in title ... is before the subsequent application is filed", is to no avail, as clearly being superseded by G 1/22. The opponents misread this decision, when stating that "the Enlarged Board even refers to the above three decisions and acknowledges this settled case law", as G 1/22 explicitly allows for retroactive transfers, and thus departs from previous jurisprudence.
34. It was further argued that the rebuttable-presumption approach could not have retroactive effect, which optionally also might lead to another referral to the Enlarged Board. Such a presumption could, in any case, not be retroactively applicable to applications and patents having a priority date before issuance of G 1/22, as this would constitute a breach of legitimate

expectations. Reference was made, *inter alia*, to G 2/08, reasons 7.1.4, where the Enlarged Board foresaw a time limit for a change in the interpretation of a substantive law provision, in order for future applications to comply with this new situation, and to G 3/19, Headnote, where the Enlarged Board defined a grace period for when the negative effect applied. In the present case, too, the users of the EPO and the public have a legitimate interest that, with respect to pending applications and granted patents, Article 87(1) EPC is interpreted in accordance with the established practice in case law before G 1/22.

35. This is also not persuasive. G 2/07 (OJ 2012, 130), reasons 2.5, established the principle that there can be no "legitimate expectations" that an interpretation of a substantive provision by the jurisprudence of the boards will not be overruled in the future by the Enlarged Board, since recognising such an expectation as legitimate would undermine the function of the Enlarged Board. The decisions as quoted by the opponents, to the contrary, concerned specific situations where a decision of the Enlarged Board had direct implications for pending or future patent applications, and were thus directly relevant to the actions that needed to be taken by the applicants.

36. This fundamentally differs from the present case, with such legitimate expectations being invoked by the opponents as - insofar - unrelated third parties with no legal interests at stake, and who did not have to take any actions in the context or in view of the filing of the patent applications in the present case. It cannot be seen - and they also do not say - on which established practice they could legitimately have relied on, and what actions they might have made based

on their expectations. If at all, it was the appellants who took actions in the context of the filing of the patent applications.

37. The Board notes that [J 8/00](#) concerned more or less the same argumentation as here, see reasons 2 to 3.3:

"This point of law has been decided by the Enlarged Board in case G 4/98 ... whether G 4/98 should not be applied to the present case because of a possible "retrospective effect" ... to mean that cases pending at the date of the decision in G 4/98 should be exempted from its application ... The ... principle of good faith has to be applied to case law which creates a new situation for users of the EPO because their legitimate expectations must be protected. This principle was applied in case G 5/88, where the Enlarged Board overruled an agreement made by the President of the EPO with the German Patent Office concerning the treatment of documents intended to be filed at the EPO. Decision G 5/93 was concerned with the re-establishment of certain time limits in PCT applications ... contrary to the "Information for PCT-Applicants", a guideline issued by the EPO in which ... it was said that re-establishment was allowed. The principle was also applied in decision G 9/93 which held that a proprietor cannot oppose his own patent, overturning the ruling in G 1/84 (OJ EPO 1985, 299). All of the three decisions in which the Enlarged Board ordered that new case law should not apply retrospectively have in common changes to prior law and practice on which users of the European patent system had relied ... Those three Enlarged Board decisions, which all had that special feature, cannot form the basis of a general rule that new case law must never be applied retrospectively ... In the present case, not only did the Enlarged Board make

no order as to the non-application of its decision in G 4/98 to pending cases, but also there was no change in prior law and practice on which users had relied. On the contrary, the Enlarged Board, by providing a definitive interpretation of ..., provided users not with a change in the law they had previously relied on but with an interpretation of the law they could rely in place of the previous uncertainty on which they could not rely. Therefore, the protection of legitimate expectations and the principle of good faith as raised ... are not in question. The interpretation of ... supplied in G 4/98 applies to the present case and serves to decide it."

38. Apart from the fact that the Enlarged Board in G 1/22 significantly changed the interpretation of the law relating to priority, the opponents seem to overlook fundamental principles of the priority system of Articles 87 to 89 EPC and the provisions of the Paris Convention for the Protection of Industrial Property when they further claim that the Enlarged Board's approach has had an adverse effect on them and third parties in general and has been harmful to them.

39. The purpose of priority is to safeguard, for a limited period, the interests of a patent applicant to obtain international protection for their invention; in the course of the revisions of the Paris convention, it was considered *"that overly strict solutions [for the priority provisions] would hardly be in accord with the spirit of the Union treaty which is aimed at fostering inventive genius ..."* (T 15/01, OJ 2006, 153, reasons 32 ff; see also T 577/11, reasons 6.5.3). The creation of the right of priority was aimed at protecting the rights of the applicant of a first application for an invention in all countries of the Paris Union by

securing the filing date as the effective date for the definition of the state of the art (T 577/11, reasons 6.5.3).

These principles have also been largely reflected in national courts' jurisprudence, for example in [Magiq Technologies v Swisscom, Court of First Instance Paris \(Tribunal de Grande Instance Paris\), 28 September 2007](#), where the purpose of priority rules was held as to safeguard a subsequent patent application against the divulgation and usurpation occurring after the priority date, or [Marcel Riendeau v Zehnder Group, Swiss Federal Patent Court \(BPatGer\), Urteil O2015 009](#), according to which the purpose of priority is to enable and simplify international patent protection. Or, as was said in [Accord Healthcare Ltd v Research Corporation Technologies, Inc \[2017\] EWHC 2711 \(Pat\); \[2018\] R.P.C. 4, para 77 ff](#), a case similar to the present: "... if priority is lost this patent would be revoked over a publication by the inventor in the period between the priority date and the filing date which ... was assumed to be a safe thing to do because it was assumed by everyone involved that priority would be successfully claimed. There will be many cases like this. There is no obvious public interest in striking down patents on this ground, unlike all the other grounds of invalidity ...".

40. It is not the purpose of Articles 87 to 89 EPC to protect third parties to the detriment of the applicants.
41. Finally, to recall again G 1/22, reasons 114: there is always a party who is entitled to claim priority. Also against this background there cannot be legitimate expectations of third parties that a priority claim is

invalid, and thus G 1/22 brings legal certainty to all involved, in particular for the parties that the system was designed to protect.

Referral of questions to the Enlarged Board of Appeal

42. Under Article 112(1)(a) EPC a board shall refer a question to the Enlarged Board if it considers that a decision is required, in order to ensure uniform application of the law, or because a point of law of fundamental importance arises.
43. The opponents have requested the submission of questions to the Enlarged Board. Their reasons for wishing to submit these questions are a mixture of uniform application of the law, and points of law of fundamental importance.
44. The "uniform application of the law", and "deviation from an earlier decision of the Enlarged Board" do not apply as the board is applying the decision of the Enlarged Board in G 1/22, which fundamentally affects the way that the boards assess priority claims, as set out in this decision.
45. The board has a discretion whether to refer questions, even if a point of law of fundamental importance is concerned (see decision T 390/90, OJ 1994, 808, reasons 2). One of the applicable criteria is whether the question can be answered beyond doubt by the board itself (see decision T 1242/04, OJ 2007, 421, reasons 10.3).
46. In this case the board has been able to answer the questions raised beyond doubt, or the questions raised were not relevant to this decision, hence no referral

is necessary.

47. In particular, the question as to a "retroactive effect" of decisions of the Enlarged Board, thus the point in time when they take effect, has already been answered by the boards' jurisprudence. Moreover, G 1/22 has given a clear answer already that also retroactive transfers of the priority right are possible under the EPC, and the relevant date for the right to claim priority. Finally, questions of the standard of proof do not arise.

Remittal of the case to the opposition division

48. All parties made requests to remit the case to the opposition division in the event that the decision of the opposition division was set aside. The opposition division revoked the patent. The patent as granted was found to not be novel. This conclusion was a direct consequence of the opposition division's finding that priority had not been validly claimed from P1, P2, P5 and P11.

The board finds such priority claims to be valid, hence it is necessary to set the decision under appeal aside and remit the case to the opposition division for further prosecution (Article 111(1) EPC and Article 11 RPBA). It will therefore be necessary to examine, for the first time, whether other grounds of opposition prejudice the maintenance of the patent as granted.

Order

For these reasons it is decided that:

1. The requests for referral to the Enlarged Board of Appeal are refused.
2. The decision under appeal is set aside.
3. The case is remitted to the Opposition Division for further prosecution.

The Registrar:

The Chair:



A. Vottner

T. Sommerfeld

Decision electronically authenticated